IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appl. No. : 09/801,996 Confirmation No. 5891
Appellant : Masahiro Hinami
Filed : March 8, 2001
TC/A.U. : 3714
Examiner : Milap Shah

Docket No. : 01-201
Customer No. : 34704

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

SUBSTITUTE APPEAL BRIEF

Dear Sir:

This Substitute Appeal Brief corrects typographical and grammatical errors in the arguments section of the Appeal Brief filed May 12, 2009.

This is an appeal to the Board of Patent Appeals and Interferences from the final rejection of claims 1, 2, 4, 7, 8 and 11 - 13, dated July 14, 2008, made by the Primary Examiner in Tech Center Art Unit 3714.

REAL PARTY IN INTEREST

The real party in interest is Konami Corporation of Tokyo, Japan.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellant, Appellant's legal representative, or Assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1, 2, 4, 7, 8, and 11 - 13 are pending in the application. Claims 1, 2, 4, 7, 8 and 11 - 13 stand rejected and are on appeal. Claims 3, 5, 6, and 9 - 10 have previously been cancelled. A true copy of the claims on appeal is attached hereto in Appendix A.

STATUS OF AMENDMENTS

An amendment dated November 14, 2008 was filed after issuance of the final rejection.

In an advisory action issued on December 3, 2008, the Examiner advised that the amendment after final rejection would be not entered for the purposes of appeal.

SUMMARY OF CLAIMED SUBJECT MATTER

The present invention as set forth in independent claim 1 relates to a game apparatus for executing a war simulation game, comprising: a first generator (130)(see Fig. 2) for generating image data to display a normal state image on a preset display, which includes a map (see page 3, lines 7 - 9 of the specification), at least one player's element (see page 3, lines 9 - 10 of the specification; also see FIG. 6, element S1), and at least one opponent's element (see page 3, line 10 of the specification), both elements being positioned on the map (see page 3, line 11 of the specification); a first controller (see FIG. 2, element 120; also see FIG. 3, element 122) for activating the first generator when operation data indicating an operation by a game player is sent to the first controller and controlling the first generator to generate the image

data for the normal state image according to the operation data (see page 3, lines 11 - 15 of the specification); a second generator for generating image data to display a combat state image on the preset display, which represents that one of the at least one player's element fights against one of the at least one opponent's element (see page 3, lines 15 - 19 of the specification); a second controller (123; see FIG. 3) for activating the second generator when the operation data is sent to the second controller and controlling the second generator to generate the image data in real time in response to the operation data (see page 3, lines 20 - 22 of the specification), wherein the real time generation of image data is free of a turn-based generation of image data(see page 26, lines 3 - 19 of the specification); and a selector (121; see FIG. 3) for receiving the operation data, determining whether or not the operation data satisfies a preset condition, and sending the operation data to either the first controller or the second controller in accordance with the determination (see page 3, lines 22 - 26 of the specification), wherein the map (M)(see FIG. 6) of the normal state image comprises a plurality of areas (M1), and each of the both elements (S1) is positioned in one of the plurality of areas respectively, wherein the second controller determines, according to the operation data, whether or not an area in which the desired player's element is positioned is adjacent to an area in which the desired opponent's element is positioned, and controls the second generator so that the displayed combat state image represents the desired player's element to fight the desired opponent's element in short-range circumstance when the area in which the desired player's element is

positioned is adjacent to the area in which the desired opponent's element is positioned, while the display combat state image represents the desired player's element to fight the desired opponent's element in long-range circumstance when the area in which the desired player's element is positioned is not adjacent to the area in which the desired opponent's element is positioned (see FIGS. 10A and 10B; also see page 28, line 11 to page 29, line 16 of the specification), and wherein the map comprises a matrix form having a plurality of geographic features that exert an influence upon a result of combat between the at least one player's element and the at least one opponent's element (see FIG. 6; also see page 21, lines 14 - 25 of the specification).

As set forth in dependent claim 2, the preset condition is whether the operation data includes an instruction that desired one of the at least one player's element should fight against desired one of the at least one opponent's element, and wherein the selector sends the operation data to the second controller when the operation data satisfies the preset condition (see page 4, lines 20 - 25 of the specification).

As set forth in dependent claim 4, the second controller detects a distance between the desired player's element and the desired opponent's element according to the operation data, and controls the second generator so that the displayed combat state image reflects the detected distance (see page 4, line 25 to page 5, line 3 of the specification).

As set forth in independent claim 6, the present invention also relates to a method of executing a war

simulation game on a game apparatus (see page 6, lines 10 - 12 of the specification), comprising: a first generating step of generating image data to display a normal state image on a preset display of the game apparatus, which includes a map, at least one player's element and at least one opponent's element, both elements being positioned on the map (see page 6, lines 12 - 16 of the specification); a first controlling step of activating the first generating step in response to reception operation data indicating an operation by a game player and controlling the first generating step to generate the image data for the normal state image according to the operation data (see page 6, lines 16 - 20 of the specification); a second generating step of generating image data to display a combat state image on the preset display, which represents that one of the at least one player's element fights against one of the at least one opponent's element (see page 6, lines 20 - 23 of the specification); a second controlling step of activating the second generating step in response to reception of the operation data and controlling the second generating step to generate the image data in real time in response to the operation data (see page 6, line 23 to page 7, line 1 of the specification), wherein the real time generation of image data is free of a turn-based generation of image data (see FIG. 6; also see page 26, lines 3 - 19 of the specification); and a selecting step of receiving the operation data, determining whether or not the operation data satisfies a preset condition, and sending the operation data to either the first controlling step or the second controlling step in accordance with the determination (see page 7, lines 1 - 5 of the specification), wherein the map (M) of the normal state

image comprises a plurality of areas (M1) having a plurality of geographic features, and each of the both elements (S1) is positioned in one of the plurality of areas respectively (see FIG. 6; also see 21, lines 14 - 25 of the specification), and further comprising: step of determining, according to the operation data, whether or not an area in which the desired player's element is positioned is adjacent to an area in which the desired opponent's element is positioned, and controlling the second generator so that the displayed combat state image represents the desired player's element to fight the desired opponent's element in short-range circumstance when the area in which the desired player's element is positioned is adjacent to the area in which the desired opponent's element is positioned, while the display combat state image represents the desired player's element to fight the desired opponent's element in long-range circumstance when the area in which the desired player's element is positioned is not adjacent to the area in which the desired opponent's element is positioned (see FIGS 10A and 10B; also see page 28, line 11 to page 29, line 25), wherein the plurality of geographic features exert an influence upon a result of combat between the at least one player's element and the at least one opponent's element (see page 21, lines 14 - 25 of the specification).

As set forth in independent claim 8, the invention also relates to a storage medium having computer readable program code means embodied in the medium (see page 7, lines 6 - 8 of the specification), the computer readable program code means comprising: first computer readable program code means for generating image data to display a normal state image on a preset display, which includes a

map, at least one player's element, and at least one opponent's element, both elements being positioned on the map (see page 7, lines 9 - 11 of the specification), wherein the map of the normal state image comprises a plurality of areas having a plurality of geographic features, and each of the both elements is positioned in one of the plurality of areas respectively; second computer readable program code means for activating the first computer readable program code means in response to reception operation data indicating an operation by a game player and controlling the first computer readable program code means to generate the image data for the normal state image according to the operation data (see page 7, lines 13 - 18 of the specification); third computer readable program code means for generating image data to display a combat state image on the preset display, which represents that one of the at least one player's element fights against one of the at least one opponent's element (see page 7, lines 18 - 22 of the specification); fourth computer readable program code means for activating the third computer readable program code means in response to reception of the operation data and controlling the third computer readable program code means to generate the image data in real time in response to the operation data (see page 7, lines 22 - 26 of the specification), wherein the real time generation of image data is free of a turn-based generation of image data (see page 21, lines 14 - 25 of the specification); and fifth computer readable program code means for receiving the operation data, determining whether or not the operation data satisfies a preset condition, and sending the operation data to either the second computer readable program code means or the fourth computer readable program

code means in accordance with the determination (see page 7, last line to page 8, line 5 of the specification), and the computer readable program code means further comprising: computer readable program code means for determining, according to the operation data, whether or not an area in which the desired player's element is positioned is adjacent to an area in which the desired opponent's element is positioned, and computer readable program code means for controlling the second generator so that the displayed combat state image represents the desired player's element to fight the desired opponent's element in short-range circumstance when the area in which the desired player's element is positioned is adjacent to the area in which the desired opponent's element is positioned, while the display combat state image represents the desired player's element to fight the desired opponent's element in long-range circumstance when the area in which the desired player's element is positioned is not adjacent to the area in which the desired opponent's element is positioned (see page 28, line 11 to page 29, line 25 of the specification; also see FIGS. 10A and 10B), and the plurality of geographic features exert an influence upon a result of combat between the at least one player's element and the at least one opponent's element (see page 21, lines 14 - 25 of the specification).

As set forth in dependent claim 11, the movements of the at least one player's element and the at least one opponent's element are influenced by the plurality of geographic features of the map (see FIG. 6; also see page 21, lines 14 - 25 of the specification).

As set forth in dependent claim 12, the movements of the at least one player's element and the at least one

opponent's element are influenced by the plurality of geographic features of the map (see FIG. 6; also see page 21, lines 14 - 25 of the specification).

As set forth in dependent claim 13, the movements of the at least one player's element and the at least one opponent's element are influenced by the plurality of geographic features of the map (see FIG. 6; also see page 21, lines 14 - 25 of the specification).

GROUND(S) OF REJECTION TO BE REVIEWED ON APPEAL

The sole ground of rejection to be reviewed on appeal is as follows:

(1) the rejection of claims 1, 2, 4, 7, 8, and 11 - 13 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,231,440 to Yamashita.

ARGUMENT

Claims 1, 2, 4, 7, 8, and 11 - 13 Are Patentable Over Yamashita

Anticipation under 35 U.S.C. 102(e) requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference". See *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987). Anticipation further requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim. *Soundscriber Corp. v. U.S.*, 360 F.2d 954, 960 (Ct. Cl. 1966); also see *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983). The phrase

"arranged as in the claim" applies to all claims and refers to the need for an anticipatory reference to show all of the limitations of the claims arranged or combined in the same way as recited in the claims, not merely in a particular order. See *Net Moneyin, Inc. v. Verisign Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2007).

To establish inherency, extrinsic evidence "must make it clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill." See *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991). Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *Id.* at 1269.

As will be discussed hereinafter, the rejection of claims 1, 2, 4, 7, 8, and 11 - 13 under 35 U.S.C. 102(e) fails because the Examiner has (1) failed to establish a proper case of inherency; and (2) has not shown, even if all elements were inherently present, that the Yamashita reference has all of the claim elements arranged in the same way as recited in the claims.

(A) Independent Claim 1 Is Not Anticipated By Yamashita

Claim 1 is directed to a game apparatus for executing a war simulation game, comprising: a first generator for generating image data to display a normal state image on a preset display, which includes a map, at least one player's element, and at least one opponent's element, both elements being positioned on the map; a first controller for activating the first generator when operation data

indicating an operation by a game player is sent to the first controller and controlling the first generator to generate the image data for the normal state image according to the operation data; a second generator for generating image data to display a combat state image on the preset display, which represents that one of the at least one player's element fights against one of the at least one opponent's element; a second controller for activating the second generator when the operation data is sent to the second controller and controlling the second generator to generate the image data in real time in response to the operation data, wherein the real time generation of image data is free of a turn-based generation of image data; and a selector for receiving the operation data, determining whether or not the operation data satisfies a preset condition, and sending the operation data to either the first controller or the second controller in accordance with the determination, wherein the map of the normal state image comprises a plurality of areas, and each of the both elements is positioned in one of the plurality of areas respectively, wherein the second controller determines, according to the operation data, whether or not an area in which the desired player's element is positioned is adjacent to an area in which the desired opponent's element is positioned, and controls the second generator so that the displayed combat state image represents the desired player's element to fight the desired opponent's element in short-range circumstance when the area in which the desired player's element is positioned is adjacent to the area in which the desired opponent's element is positioned, while the display combat state image represents the desired player's element to

fight the desired opponent's element in long-range circumstance when the area in which the desired player's element is positioned is not adjacent to the area in which the desired opponent's element is positioned, and wherein the map comprises a matrix form having a plurality of geographic features that exert an influence upon a result of combat between the at least one player's element and the at least one opponent's element.

The Examiner states that Yamashita generally teaches a game system in which two fighting characters may battle in terms of short-range means or long-range means depending on the distance determined by the computer. See page 2 of the final rejection. Appellant does not dispute that Yamashita generally teaches a game system in which two characters, one operated by a player, and the other operated by the computer, may battle. Appellant does not disagree that the weapons used by the player's figure C1 and the computer's figure C2 change as a function of distance between C1 and C2. Where Appellant disagrees with the Examiner, and where the Examiner has committed reversible error, is the conclusion that virtually all of the features set forth in claim 1 are "inherently" present in Yamashita.

In rejecting claim 1, the Examiner makes the following statements on pages 2 and 3 of the final rejection:

"For such an operation to properly work, there must be inherent processes within the computing to carry out the generation of images representing the short range and long range means. Therefore, the Examiner submits the following are inherent within Yamashita: Yamashita must inherently (i.e. necessarily present) include a first generator having a first controller (fig. 3, CPU 101) for generating and

controlling data representing a normal state, wherein normal state imaging appears to be the imaging in which the two characters are simply displayed in a state in which they are "about to battle": … a second generator and second controller (fig. 3, CPU 101) for generating and controlling data presenting the combat state wherein the combat state imaging appears to be the imaging in which the two characters are actually fighting. The second controller that generates the combat state is considered to generate such a state in real time (i.e. as the players are playing the game), where the fighting game of Yamashita does not appear to be a turn-based game, thus would not have any turn-based generation of image data and only real-time generation of image data during play of the game. Yamashita inherently includes a plurality of areas in the normal state stage image, such that the two characters C1 and C2 positioned in Figure 4 may be considered to be positioned in one of the areas or two of the areas as each of the plurality of areas does not appear to have any bounds and it appears that the limitation may even be broadly interpreted as each pixel within the imaging is one of the plurality of areas …; Yamashita must also inherently include the 'selector" for selecting the combat state imaging since it should have been determined that the two characters CI and C2 are not in adjacent areas and thus require a combat state image to battle in long range means…. Yamashita also discloses the map comprises a matrix form having a plurality of geographic features that exert an influence upon the movement and result of combat between the at least one player's element and the at least one opponent's element (column 4, lines 15 - 18)."

Appellant submits that the rejection fails because the Examiner's interpretation is contrary to the written disclosure in Yamashita and because the Examiner has presented no extrinsic evidence which would establish that the missing descriptive matter is "necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill." See *Continental Can Co.*, 948 F.2d at 1268.

In column 3, line 16, Yamashita says that "a controller comprise a CPU 101, …" There is no disclosure in Yamashita et al. of a second controller. The Examiner in rejecting claim 1 points to CPU 101 as being the first controller and the second controller. This is contrary to the explicit written language of Yamashita which says that "a controller" comprises a CPU 101.

As for the inherency arguments presented by the Examiner, there is no extrinsic evidence of record which establishes that (1) the first generator, (2) the first controller for activating the first generator, (3) the second generator, (4) the second controller for activating the second generator, and (5) the selector for receiving the operation data, determining whether or not the operation data satisfies a preset condition and sending the operation data to either the first controller or the second controller according to the determination are necessarily present in Yamashita's system and would be so recognized by one of ordinary skill in the art. It should be apparent that there are an unlimited number of ways for the program in Yamashita's system to function to provide the movement of, and the combat between, figures C1 and C2. Clearly, Yamashita uses a single controller, CPU 101, to operate the

program. Thus, the inherency argument presented by the Examiner fails on its face. Assuming arguendo, that the Examiner could reasonably argue that there were two controllers, at best, the Examiner has presented a case of mere possibility and this is insufficient to establish anticipation under 35 U.S.C. 102(e). See *Continental Can Co.*, 948 F.2d at 1269. Appellant submits that Examiner argument is not a substitution for extrinsic evidence which would establish that the only way for Yamashita to perform its game is to have the components set forth in the claim.

Even if the Examiner could say that a second controller was present, there is no evidence that the second controller determines, according to the operation data, whether or not an area in which the desired player's element is position is adjacent to an area in which the desired opponent's element is positioned. Yamashita is totally silent on this point. For all anyone knows from a reading of Yamashita, some other feature performs such a determination. Still further, there is nothing in Yamashita which would let one conclude that the second controller controls the second generator so that the displayed combat state image represents the desired player's element to fight the desired opponent's element in short-range circumstance when the area in which the desired player's element is positioned is adjacent to the area in which the desired opponent's element is positioned, while the display combat state image represents the desired player's element to fight the desired opponent's element in long-range circumstance when the area in which the desired player's element is positioned is not adjacent to the area in which the desired opponent's element is positioned.

Here again, Yamashita is silent on how this works in his system. Thus, even if the Examiner can show a second controller is inherently present, the Examiner has not shown that the second controller necessarily performs the claimed control of the second generator.

On the issue of the Examiner's failure to establish inherency through the presentation of extrinsic evidence, the Examiner needs to listen to himself. On page 7 of the office action, the Examiner states that "[t]he majority of fighting or battle games will encompass images and game states as described in these claims." It should be apparent to the Examiner that these fighting or battle games are not all using the same components and the same programming. The reason why the Examiner has not presented the required extrinsic evidence is that Appellant is correct when he presents the argument that there is no one way to enable these games. Thus, by the Examiner's own admission, it can not be said that the features of claim 1 are necessarily present in Yamashita.

Finally, there is nothing in Yamashita which says that the map comprises a matrix form having a plurality of geographic features that exert an influence upon a result of combat between the at least one player's element and the at least one opponent's element. Yamashita's display may be a map and there may be depicted geographic features; however, Yamashita does not say that the features exert an influence upon the combat results. Nothing of this nature appears in column 4, lines 15 - 18 of Yamashita.

For these reasons, it is submitted that the Examiner has failed to make out a case of inherency.

The rejection further fails because the Examiner, assuming that all of these elements were somehow inherently present in Yamashita, has failed to establish that the elements are arranged in or combined in the same way as recited in the claims. See *Net Moneyin*, 545 F.3d at 1369. There is nothing which would lead one to conclude that there is (1) a first controller for activating the first generator when operation data indicating an operation by a game player is sent to the first controller and controlling the first generator to generate the image data for the normal state image according to the operation data; (2) a second generator for generating image data to display a combat state image on the preset display, which represents that one of the at least one player's element fights against one of the at least one opponent's element; (3) a second controller for activating the second generator when the operation data is sent to the second controller and controlling the second generator to generate the image data in real time in response to the operation data, wherein the real time generation of image data is free of a turn-based generation of image data; and (4) a selector for receiving the operation data, determining whether or not the operation data satisfies a preset condition, and sending the operation data to either the first controller or the second controller in accordance with the determination,

For these reasons, the rejection of claim 1 fails.

(B) Independent Claim 7 Is Not Anticipated By Yamashita

Independent Claim 7 is directed to a method of executing a war simulation game on a game apparatus,

comprising: a first generating step of generating image data to display a normal state image on a preset display of the game apparatus, which includes a map, at least one player's element and at least one opponent's element, both elements being positioned on the map; a first controlling step of activating the first generating step in response to reception operation data indicating an operation by a game player and controlling the first generating step to generate the image data for the normal state image according to the operation data; a second generating step of generating image data to display a combat state image on the preset display, which represents that one of the at least one player's element fights against one of the at least one opponent's element; a second controlling step of activating the second generating step in response to reception of the operation data and controlling the second generating step to generate the image data in real time in response to the operation data, wherein the real time generation of image data is free of a turn-based generation of image data; and a selecting step of receiving the operation data, determining whether or not the operation data satisfies a preset condition, and sending the operation data to either the first controlling step or the second controlling step in accordance with the determination, wherein the map of the normal state image comprises a plurality of areas having a plurality of geographic features, and each of the both elements is positioned in one of the plurality of areas respectively, and further comprising: step of determining, according to the operation data, whether or not an area in which the desired player's element is positioned is adjacent to an area in which the desired opponent's element is positioned,

and controlling the second generator so that the displayed combat state image represents the desired player's element to fight the desired opponent's element in short-range circumstance when the area in which the desired player's element is positioned is adjacent to the area in which the desired opponent's element is positioned, while the display combat state image represents the desired player's element to fight the desired opponent's element in long-range circumstance when the area in which the desired player's element is positioned is not adjacent to the area in which the desired opponent's element is positioned, wherein the plurality of geographic features exert an influence upon a result of combat between the at least one player's element and the at least one opponent's element.

The Examiner rejects claim 7 on an inherency argument using the statements from pages 2 and 3 quoted hereinbefore. There is no detailed analysis of Yamashita provided by the Examiner which would set forth where each and every claimed method step is disclosed either expressly or inherently in Yamashita. Thus, on its face, the rejection is defective.

As pointed out above, the Examiner has not established through the use of extrinsic evidence that the following elements are necessarily present in Yamashita and would be recognized by one of skill in the art: (1) the first generator, (2) the first controller for activating the first generator, (3) the second generator, (4) the second controller for activating the second generator, and (5) the selector for receiving the operation data, determining whether or not the operation data satisfies a preset condition and sending the operation data to either the

first controller or the second controller according to the determination are necessarily present in Yamashita's system and would be so recognized by one of ordinary skill in the art. It should be apparent that there are an unlimited number of ways for the program in Yamashita's system to function to provide the movement of, and the combat between, figures C1 and C2. Yamashita expressly says that a single controller, CPU 101, is used to operate the program. Thus, the inherency argument presented by the Examiner fails on its face.

Since there is only one disclosed controller in Yamashita, there is no way Yamashita would perform the steps of: (1) a second controlling step of activating the second generating step in response to reception of the operation data and controlling the second generating step to generate the image data in real time in response to the operation data, wherein the real time generation of image data is free of a turn-based generation of image data; and (2) a selecting step of receiving the operation data, determining whether or not the operation data satisfies a preset condition, and sending the operation data to either the first controlling step or the second controlling step in accordance with the determination. There is absolutely nothing in Yamashita which necessitates that the aforementioned selecting step is performed. The operation of the program in Yamashita is not sufficiently detailed to enable one to say that the selecting step is necessarily performed.

Nor is there anything in Yamashita which would allow one to conclude that the step of controlling the second generator so that the displayed combat state image

represents the desired player's element to fight the desired opponent's element in short-range circumstance when the area in which the desired player's element is positioned is adjacent to the area in which the desired opponent's element is positioned, while the display combat state image represents the desired player's element to fight the desired opponent's element in long-range circumstance when the area in which the desired player's element is positioned is not adjacent to the area in which the desired opponent's element is positioned, is necessarily performed. At best, there is a possibility that such a step is performed; however, mere possibilities are insufficient to establish anticipation. Even if one could say that it was a probability that such a step was performed, that too is insufficient to establish anticipation. See *Continental Can Co.*, 948 F.2d at 1269.

For these reasons, the rejection of claim 7 fails.

(C) Independent Claim 8 Is Not Anticipated By Yamashita

Independent Claim 8 is directed to a storage medium having computer readable program code means embodied in the medium, the computer readable program code means comprising: first computer readable program code means for generating image data to display a normal state image on a preset display, which includes a map, at least one player's element, and at least one opponent's element, both elements being positioned on the map, wherein the map of the normal state image comprises a plurality of areas having a plurality of geographic features, and each of the both elements is positioned in one of the plurality of areas

respectively; second computer readable program code means for activating the first computer readable program code means in response to reception operation data indicating an operation by a game player and controlling the first computer readable program code means to generate the image data for the normal state image according to the operation data; third computer readable program code means for generating image data to display a combat state image on the preset display, which represents that one of the at least one player's element fights against one of the at least one opponent's element; fourth computer readable program code means for activating the third computer readable program code means in response to reception of the operation data and controlling the third computer readable program code means to generate the image data in real time in response to the operation data, wherein the real time generation of image data is free of a turn-based generation of image data; and fifth computer readable program code means for receiving the operation data, determining whether or not the operation data satisfies a preset condition, and sending the operation data to either the second computer readable program code means or the fourth computer readable program code means in accordance with the determination, and the computer readable program code means further comprising: computer readable program code means for determining, according to the operation data, whether or not an area in which the desired player's element is positioned is adjacent to an area in which the desired opponent's element is positioned, and computer readable program code means for controlling the second generator so that the displayed combat state image represents the desired player's element to fight the desired opponent's

element in short-range circumstance when the area in which the desired player's element is positioned is adjacent to the area in which the desired opponent's element is positioned, while the display combat state image represents the desired player's element to fight the desired opponent's element in long-range circumstance when the area in which the desired player's element is positioned is not adjacent to the area in which the desired opponent's element is positioned, and the plurality of geographic features exert an influence upon a result of combat between the at least one player's element and the at least one opponent's element.

The rejection of claim 8 is based upon the same inherency argument as that used to reject claims 1 and 7. Nowhere does the Examiner in rejecting claim 8 point out where the first computer readable program code, the second computer readable program code means, the third computer readable code means, the fourth computer readable code means, and the fifth computer readable code means can be found in Yamashita. Clearly, Yamashita involves a computer program but its composition is unknown from a reading of Yamashita. The Examiner has not provided any extrinsic evidence which makes it clear that these five computer readable code means are necessarily present in Yamashita's program and would be recognized as being present by one of skill in the art.

Still further, the Examiner has not pointed out where the following computer readable program means can be found in Yamashita: computer readable program code means for determining, according to the operation data, whether or not an area in which the desired player's element is

positioned is adjacent to an area in which the desired opponent's element is positioned, and computer readable program code means for controlling the second generator so that the displayed combat state image represents the desired player's element to fight the desired opponent's element in short-range circumstance when the area in which the desired player's element is positioned is adjacent to the area in which the desired opponent's element is positioned, while the display combat state image represents the desired player's element to fight the desired opponent's element in long-range circumstance when the area in which the desired player's element is positioned is not adjacent to the area in which the desired opponent's element is positioned. Nor has the Examiner established through extrinsic evidence that these computer readable program means are necessarily present and would be recognized as being present by one of skill in the art.

For these reasons, claim 8 is not anticipated by Yamashita.

(D) Patentability of Claims 2, 4, and 11 - 13.

At a minimum, claims 2, 4, and 11 - 13 are allowable for the same reasons as their parent claims.

Claim 2 calls for the selector to send operation data to the second controller when the operation data satisfies the preset condition set forth in the claim. As discussed above, there is no second controller in Yamashita. Yamashita is very clear that there is only a controller which comprises CPU 101. Thus, the Examiner is wrong when he says that there are two controllers. Such an argument

flies in the face of the written description of Yamashita. Further, as pointed out above, there is no selector present in Yamashita either inherently or expressly. Since there is no selector and no second controller, the limitation "wherein the selector sends the operation data to the second controller when the operation data satisfies the preset condition" is not met by Yamashita, either inherently or expressly. For these reasons, claim 2 is independently allowable

Claim 4 is directed to the second controller detecting a distance between the desired player's element and the desired opponent's element according to the operation data, and controls the second generator so that the displayed combat state image reflects the detected distance. As discussed above, Yamashita discloses only one controller. There is no second controller. Even if one could somehow argue that a second controller was present in Yamashita, there is no disclosure of the second controller detecting the distance between the two elements according to the operation data. The Examiner has not established via extrinsic evidence such a controller is present in Yamashita and even if it were present would perform the claimed distance detection. Still further, the Examiner has not established via extrinsic evidence that the second controller, if present, controls the second generator in the manner set forth in the claim. For these reasons, claim 4 is independently allowable.

Claims 11 - 13 stand and fall with their parent claims.

CONCLUSION

For the foregoing reasons, the Board is hereby requested to reverse the rejections of record and remand the instant application back to the Primary Examiner for allowance.

APPEAL BRIEF FEE AND EXTENSION OF TIME

A request for a two month extension of time is enclosed herewith. The Director is hereby authorized to charge the Appeal Brief Fee of $540.00 and the extension of time fee in the amount of $490.00 to Deposit Account No. 02-0184. Should the Director determine that an additional fee is due, he is hereby authorized to charge said additional fee to said Deposit Account.

Respectfully submitted,

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APPENDIX A - CLAIMS ON APPEAL

1. A game apparatus for executing a war simulation game, comprising:

a first generator for generating image data to display a normal state image on a preset display, which includes a map, at least one player's element, and at least one opponent's element, both elements being positioned on the map;

a first controller for activating the first generator when operation data indicating an operation by a game player is sent to the first controller and controlling the first generator to generate the image data for the normal state image according to the operation data;

a second generator for generating image data to display a combat state image on the preset display, which represents that one of the at least one player's element fights against one of the at least one opponent's element;

a second controller for activating the second generator when the operation data is sent to the second controller and controlling the second generator to generate the image data in real time in response to the operation data, wherein the real time generation of image data is free of a turn-based generation of image data; and

a selector for receiving the operation data, determining whether or not the operation data satisfies a preset condition, and sending the operation data to either the first controller or the second controller in accordance with the determination

wherein the map of the normal state image comprises a plurality of areas, and each of the both elements is positioned in one of the plurality of areas respectively,

wherein the second controller determines, according to the operation data, whether or not an area in which the desired player's element is positioned is adjacent to an area in which the desired opponent's element is positioned, and controls the second generator so that the displayed combat state image represents the desired player's element to fight the desired opponent's element in short-range circumstance when the area in which the desired player's element is positioned is adjacent to the area in which the desired opponent's element is positioned, while the display combat state image represents the desired player's element to fight the desired opponent's element in long-range circumstance when the area in which the desired player's element is positioned is not adjacent to the area in which the desired opponent's element is positioned, and

wherein the map comprises a matrix form having a plurality of geographic features that exert an influence upon a result of combat between the at least one player's element and the at least one opponent's element.

2. The game apparatus according to claim 1, wherein the preset condition is whether the operation data includes an instruction that desired one of the at least one player's element should fight against desired one of the at least one opponent's element, and wherein the selector sends the operation data to the second controller when the operation data satisfies the preset condition.

4. The game apparatus according to claim 1, wherein the second controller detects a distance between the desired player's element and the desired opponent's element according to the operation data, and controls the second generator so that the displayed combat state image reflects the detected distance.

7. A method of executing a war simulation game on a game apparatus, comprising:

a first generating step of generating image data to display a normal state image on a preset display of the game apparatus, which includes a map, at least one player's element and at least one opponent's element, both elements being positioned on the map;

a first controlling step of activating the first generating step in response to reception operation data indicating an operation by a game player and controlling the first generating step to generate the image data for the normal state image according to the operation data;

a second generating step of generating image data to display a combat state image on the preset display, which represents that one of the at least one player's element fights against one of the at least one opponent's element;

a second controlling step of activating the second generating step in response to reception of the operation data and controlling the second generating step to generate the image data in real time in response to the operation data, wherein the real time generation of image data is free of a turn-based generation of image data; and

a selecting step of receiving the operation data, determining whether or not the operation data satisfies a preset condition, and sending the operation data to either

the first controlling step or the second controlling step in accordance with the determination,

wherein the map of the normal state image comprises a plurality of areas having a plurality of geographic features, and each of the both elements is positioned in one of the plurality of areas respectively, and further comprising:

step of determining, according to the operation data, whether or not an area in which the desired player's element is positioned is adjacent to an area in which the desired opponent's element is positioned, and

controlling the second generator so that the displayed combat state image represents the desired player's element to fight the desired opponent's element in short-range circumstance when the area in which the desired player's element is positioned is adjacent to the area in which the desired opponent's element is positioned, while the display combat state image represents the desired player's element to fight the desired opponent's element in long-range circumstance when the area in which the desired player's element is positioned is not adjacent to the area in which the desired opponent's element is positioned,

wherein the plurality of geographic features exert an influence upon a result of combat between the at least one player's element and the at least one opponent's element.

8. A storage medium having computer readable program code means embodied in the medium, the computer readable program code means comprising:

first computer readable program code means for generating image data to display a normal state image on a preset display, which includes a map, at least one player's

element, and at least one opponent's element, both elements being positioned on the map, wherein the map of the normal state image comprises a plurality of areas having a plurality of geographic features, and each of the both elements is positioned in one of the plurality of areas respectively;

second computer readable program code means for activating the first computer readable program code means in response to reception operation data indicating an operation by a game player and controlling the first computer readable program code means to generate the image data for the normal state image according to the operation data;

third computer readable program code means for generating image data to display a combat state image on the preset display, which represents that one of the at least one player's element fights against one of the at least one opponent's element;

fourth computer readable program code means for activating the third computer readable program code means in response to reception of the operation data and controlling the third computer readable program code means to generate the image data in real time in response to the operation data, wherein the real time generation of image data is free of a turn-based generation of image data; and

fifth computer readable program code means for receiving the operation data, determining whether or not the operation data satisfies a preset condition, and sending the operation data to either the second computer readable program code means or the fourth computer readable program code means in accordance with the determination,

and the computer readable program code means further comprising:

computer readable program code means for determining, according to the operation data, whether or not an area in which the desired player's element is positioned is adjacent to an area in which the desired opponent's element is positioned, and

computer readable program code means for controlling the second generator so that the displayed combat state image represents the desired player's element to fight the desired opponent's element in short-range circumstance when the area in which the desired player's element is positioned is adjacent to the area in which the desired opponent's element is positioned, while the display combat state image represents the desired player's element to fight the desired opponent's element in long-range circumstance when the area in which the desired player's element is positioned is not adjacent to the area in which the desired opponent's element is positioned, and the plurality of geographic features exert an influence upon a result of combat between the at least one player's element and the at least one opponent's element.

11. The game apparatus of claim 1, wherein the movements of the at least one player's element and the at least one opponent's element are influenced by the plurality of geographic features of the map.

12. The method of claim 7, wherein the movements of the at least one player's element and the at least one opponent's element are influenced by the plurality of geographic features of the map.

13. The storage medium of claim 8, wherein the movements of the at least one player's element and the at least one opponent's element are influenced by the plurality of geographic features of the map.

APPENDIX B - EVIDENCE

NOT APPLICABLE

APPENDIX C - RELATED PROCEEDINGS

NOT APPLICABLE